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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,313	04/25/2000	Amit D. Agarwal	23984-13939 US	9641
758 FENWICK & WEST LLP 7590 SILICON VALLEY CENTER 12/01/2008 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER				
BUCHANAN, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
12/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: AMIT AGARWAL

Application No. 09/558,313
Technology Center 3600

Mailed: December 1, 2008

Before Krista Zele, *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on March 28, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

EXAMINER'S CONSIDERATION OF AMENDMENT

The Examiner must consider and acknowledge receipt of the Amendment filed December 10, 2007, via written communication.

MPEP § 1206 states:

Examiners must respond to all amendments filed after appeal has been taken and prior to termination of the appeal. If the examiner indicates (in the advisory action) that an amendment would be entered, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be impacted by the entry of the amendment except where an amendment merely cancels claims.

EXAMINER'S ANSWER

On December 5, 2007, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the Manual of Patent Examining Procedure (MPEP). The Examiner's Answer (page 3) introduces a new ground of rejection for claims 39-41 and 44¹. Specifically, Claims 1-26 and 36-44 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376) in view of Ono (US 5,909,023). When a new ground of rejection is introduced in the Examiner's Answer a listing of any new grounds of rejection (prominently identified, e.g., a separate heading with all capitalized letters) that has been approved by the TC Director or a designee. See *Manual of Patent Examining Procedure*, §1207.02(A)(6)(d).

¹ Claims 1-26, 36-38 and 42-43 under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376) in view of Ono (US 5,909,023) were rejected in the Non-Final Rejection mailed December 29, 2005

Application No. 09/558,313

A review of the application reveals that claims 39-41 and 44 were never discussed in the statement of rejections in the Non-Final Rejection mailed December 29, 2005.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to consider the Amendment filed December 10, 2007;
- 2) vacate the Examiner's Answer mailed December 5, 2007, and issue a revised Examiner's Answer in accordance MPEP § 1207.02 as noted above;
and
- 3) for such further action as may be appropriate.

KZ/tsj

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